

**Response Under 37 C.F.R. §1.116**

Serial No.: 09/888,732

Confirmation No.: 2092

Filed: June 25, 2001

For: RESPIRATOR VALVE

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The Office Action asserts that the Examiner cannot withdraw the provisional rejection because "a provisional nonstatutory double patenting rejection has only been made in the instant application". Office Action, p. 2. Applicants respectfully assert, however, that refusal to withdraw the provisional double patenting rejection is inconsistent with purposes behind the purposes of obviousness-type double patenting rejections.

MPEP §804(I)(B) provides in part as follows:

The "provisional" double patenting rejection should continue to be made by the examiner in each application as long as there are conflicting claims in more than one application *unless that "provisional" double patenting rejection is the only rejection remaining in one of the applications. If the "provisional" double patenting rejection in one application is the only rejection remaining in that application, the examiner should then withdraw that rejection and permit the application to issue as a patent*, thereby converting the "provisional" double patenting rejection in the other application(s) into a double patenting rejection at the time the one application issues as a patent. (Emphasis added throughout.)

It is wholly arbitrary and capricious to prevent the claims in the present application from issuing because, by random chance, it and the co-pending application on which the provisional double-patenting rejection is based were assigned to different examiners instead of the same examiner. The Office and the examining corps act as a body. Having made the provisional rejection in the present application, it is the responsibility of the Office to determine whether a corresponding double patenting rejection should be entered in co-pending U.S. Patent App. No. 09/888,943, and, if proper, enter such a rejection in that application.

Furthermore, the ephemeral nature of a provisional double patenting rejection provides an additional basis for Applicants' position that the provisional double patenting rejection in the present application must be withdrawn. To require Applicants to submit a Terminal Disclaimer based on claims that have not issued is unjust and does not serve the purpose of preventing double patenting. The claims in the co-pending application upon which the provisional rejection is based may be amended or canceled such that the double patenting rejection is improper.

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For example, the provisional double patenting rejection in the present application is based on claims 1-18 of co-pending U.S. Patent App. No. 09/888,943. Applicants are submitting herewith a copy of the most recent Office Action received in that application (dated 29 June 2004 – attached as Exhibit A) and the Amendment and Response filed thereto on even date herewith (attached as Exhibit B). In the response, claims 1-14 are canceled and independent claim 15 is amended (with claims 16-18 depending from amended claim 15). As a result, there are serious questions as to the propriety of the provisional double-patenting rejection that would require reconsideration of the rejection – all in the absence of any action in the present application.

Applicants submit that this situation demonstrates precisely why, when a provisional double patenting rejection over a co-pending patent application is the only rejection remaining in a pending application, it must be withdrawn such that the allowable claims can proceed to issuance. The claims in the co-pending application on which this provisional double-patenting rejection have changed and may continue to change. Every change in the claims would require the Examiner in the present application to reconsider whether or not the provisional double patenting rejection is proper. If, however, the claims in the present application are allowed to issue, a non-provisional double patenting rejection (if proper) could be made in the co-pending application upon issuance of the claims in the present application.

For at least these reasons, Applicants respectfully submit that claims 1, 3, 7-11, 13-21, 34-46, 49-53, and 56 are patentable and withdrawal of the provisional double patenting rejection is respectfully requested.

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**Summary**

In view of the remarks herein, it is respectfully submitted that claims 1, 3, 7-11, 13-21, 34-46, 49-53, and 56 are all in condition for allowance and notification to that effect is respectfully requested. If the Examiner thinks that contacting Applicant's attorney via telephone will advance the prosecution of this case, the Examiner is invited to call at the number given below.

Respectfully submitted for  
MITTLESTADT et al.

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19 OCTOBER 2004

Date

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**CERTIFICATE UNDER 37 CFR §1.8:**

The undersigned hereby certifies that the Transmittal Letter and the paper(s), as described hereinabove, are being transmitted by facsimile in accordance with 37 CFR §1.6(d) to the Patent and Trademark Office, addressed to Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 19<sup>th</sup> day of October, 2004, at 12:30 p.m. (Central Time).

By: Rachel Gagliardi-Brown  
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